

## **Remarks**

In response to the Office Action dated March 13, 2007, Applicant respectfully requests reconsideration based on the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance. Claims 1, 16, 17 and 20 have been amended.

## **Interview Summary**

A telephone interview was held on April 23 between the Applicant's representative, Arno Naeckel, and Examiner Rose. During the interview it was discussed that the §103 rejections were ambiguous as to the references being applied. The §103 rejections for claims 9-14 were restated by the Examiner in the instant interview to be under the combination of Breck in view of Birrell and rejection of claims 18-19 has been restated to be under Breck in view of Purcell. It was further discussed that Breck was deficient in disclosing all of the claim elements concerning the independent claims under §102 as the Office Action was apparently equating the recited "information in a private database" to widely disparate elements in Becker. No agreement was reached in identifying what was describing the "information in the private database" as recited in the claims.

## **Claim Rejections - 35 U.S.C. §102**

In the Office Action, claims 1-3, 8, 15-17 and 20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Breck et al. (U.S. Pat. App. 2003/013063). The Examiner has clarified that the Office Action is actually referring to U.S. patent application 2003/0131063 to Breck since the cited document number is not a proper document number. The Applicant respectfully traverses the rejections.

Amended independent claim 1 specifies a method for retrieving information in a private database, the method comprising at an e-mail server receiving a request from a wireless communication device to retrieve the information in the private database. Upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing retrieval from the private database, sending a query to retrieve the information, receiving a response to the query, wherein the response includes the

information, wherein the information comprises a list of documents which are listed by order of relevance and sending the information to the wireless communication device. If the identified e-mail address is not on the list, then denying the request to retrieve the information in the private database.

It is respectfully submitted that Breck fails to teach each and every feature specified in independent claim 1. For example, Breck fails to describe receiving a request from a wireless communication device to *retrieve the information in the private database*. In contrast, the cited paragraphs from Breck merely describe processing a message to determine whether the user would allow the message to be delivered. (Para. 0014-0019). Processing a message to determine if a message should be delivered is not retrieving information in a private database. Delivering a message is a fundamentally different act from retrieving information.

As another example, Breck fails to describe an *e-mail server sending a query to retrieve the information [from the private database]*. To the contrary, the citation asserted by the Office Action to describe this subject matter actually describes that the Domain Administrator associates the e-mail source with a blocked status and determines whether it will allow the e-mail **delivery**. (Para. 0085). There is no query from an e-mail server to retrieve information from a private database described in Breck. Breck merely describes processing a new message and authorizing delivery of the new message based on its source address and the recipient preferences. Processing an email message by a Domain Administrator by determining a blocked/unblocked status of the message source is not sending a query to a private database to retrieve information. Breck simply does not describe retrieval of information based on a query from the e-mail server to a private database particularly where the information is recited to be a list of documents.

As a further example, Breck fails to describe receiving a response [by the e-mail server from the database] to the query wherein the response includes the information and wherein the information comprises a list of documents which are listed by order of relevance. The Office Action cites paragraph [0047] as describing “receiving a response to the query, wherein the response includes the information” [from the database]. However, Paragraph 0047 is actually describing that the recipient may simply send a reply e-mail. It appears that the Office Action is attempting to **equate the recipient’s outgoing e-mail to the “information” recited in the claims** which is further recited as being a list of documents from the private database. However,

Breck does not describe a response to a query being sent from a database to the e-mail server or that a list of documents is sent from a private database in response to the query. A mere reply email from an e-mail server by a user is not describing that the e-mail server is receiving a response [from the private database] to the query, wherein the response includes the information and wherein the information comprises a list of documents which are listed by order of relevance. Receiving a query response by an e-mail server from a database is a completely different act than merely sending a reply e-mail from an e-mail server.

Further still, the Office Action fails to describe that the “information comprises a list of documents, which are listed by order of relevance”. The Office Action cites paragraph 0090 for describing that the “information comprises a list of documents, which are listed by order of relevance”. Paragraph 0090 actually describes a decision hierarchical authority and the possible blocking of an outgoing reply message by a superior authority. Breck does not describe that the information retrieved comprises a list of documents, which are listed by order of relevance. Breck describes the blocking of an outgoing e-mail from a child by a parent as an example of Breck’s hierarchical/priority processing of outgoing e-mail. Breck is not describing that the information comprises a list of documents which are listed by order of relevance. Breck is describing release authority not document relevance.

In addition to Breck not describing at least the above discussed claim elements, Applicants respectfully point out that the term “information in the private database” as consistently recited in various elements of independent claim 1 is being equated erratically by the Office Action to several disparate features described in Breck. The Office Action is equating the recited information in a private database to **stored e-mail in a recipient’s e-mail server** as opposed to one claim recitation and to **blocked/unblocked status information** as opposed to another claim recitation and then to **outgoing e-mail messages** as opposed to a third claim recitation. Applicants respectfully point out that ascertaining the differences between the prior art and the claims at issue require the invention and the prior art be evaluated as a whole. MPEP 2111-2116. Even if the prior art performs all of the functions recited in the claim, the prior art can not anticipate the claim if there are any structural differences. MPEP 2114. Applicants respectfully assert that the mere fact that the Office Action is resigned to being unable to point to one consistent feature in Breck as being the “information in the private database” and must necessarily rely on multiple discordant and/or conflicting features in Breck to allegedly

anticipate the same “information in a private database” recitation in different elements of independent claim 1, demonstrates that there is at least one structural difference between the Breck reference and independent claim 1. As such, Breck when read as a whole as required can not anticipate each and every element of independent claim 1. As such, independent claim 1 is allowable for at least this additional reason.

Based on the foregoing, Applicants respectfully assert that Breck fails to describe each and every recitation of the subject matter asserted to Breck by the Office Action. Therefore, it is respectfully submitted that independent claim 1 is allowable and the rejection of this claim should be withdrawn. Claims 2-3 and 8-16 depend from independent claim 1 and thus specify at least the same features. Therefore, these claims are allowable for at least the same reasons.

Independent claims 16, 17 and 20 specify similar features as independent claim 1 and thus are also allowable for at least the same reasons. Rejected dependent claims 18-19 depend from an allowable independent claim 17 and are allowable for at least the same reasons.

### **Claim Rejections - 35 U.S.C. §103**

As a preliminary matter, Applicant was unsure of the basis for rejection of claims 9-14 and 18-19. The Office Action rejects dependent claims 9-14 under 35 USC §103(a) as being unpatentable over Birrell (US Pat. 6,185,551). The Office Action rejects dependent claims 18 and 19 under 35 USC §103(a) under Birrell view of Purcell (US Pat. 5,940,807).

In the previous Office Action dated November 13, 2006, claims 9-14 were initially rejected as being rejected under Birrell and claims 18-19 were rejected under Birrell in view of Purcell. During the November 13<sup>th</sup> interview, the Examiner recast her rejection of claims 9-14 and 18-19 to be under Birrell in view of Purcell only and NOT Breck in view of Purcell and further in view of Purcell.

Applicants respectfully point out that the in the current Office Action, claims 9-14 were again rejected under Birrell and claims 18-19 were rejected under Birrell in view of Purcell. When asked for clarification, the Examiner again verbally recast her rejections and is now rejecting claims 9-14 under Breck in view of Birrell and claims 18-19 under Breck in view of Purcell. Applicants respectfully traverse these rejections under Breck in view of Birrell and under Breck in view of Purcell.

#### Claims 9-14

Claims 9-14 depend from an allowable amended independent claim 1 as Breck fails to describe the subject matter asserted to it by the Office Action. Because claims 9-14 depend from an allowable independent claim 1, claims 9-14 are also allowable for at least the same reasons.

Applicants respectfully note that Birrell concerns itself with managing e-mail accounts in a distributed network. Birrell does not describe an e-mail server receiving a request from a wireless communication device to retrieve the information in the private database or upon receiving the request, comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server and if the identified e-mail address is on the list, then authorizing access to the private database. Nor does Birrell concern itself with sending a query from an e-mail server to retrieve the information, receiving a response to the query, wherein the response includes the information and wherein the information comprises a list of documents which are listed by order of relevance and sending the information to the wireless communication device.

Therefore, because Breck fails to describe the subject matter asserted by the Office Action to Breck and Birrell fails to cure these additional deficiencies, the combination of Breck and Birrell fails to describe each and every element of claims 9-14 claim. Claims 9-14 are therefore allowable over the combination of Breck and Birrell for at least these reasons.

#### Claims 18-19

As discussed above in regards to the §102 rejections, claims 18-19 depend from an allowable amended independent claim 17 and are allowable for at least the same reasons. Purcell concerns itself with managing e-mail accounts in a distributed network and does not address comparing an e-mail address identified with the wireless communication device against a list of e-mail addresses residing at the e-mail server and if the identified e-mail address is on the list, then authorizing access to the private database. Purcell does not concern itself with e-mail server retrieving information from the private database and forwarding the information to the wireless communication device, wherein the authorization module is operative to compare the e-mail address identified with the wireless communication device against a list of e-mail addresses

residing at the e-mail server, and if the identified e-mail address is on the list, then authorizing access to the private database, and if the identified e-mail address is not on the list, then denying the request to retrieve the information in the private database, wherein the information comprises a list of documents which are listed by order of relevance. As none of Breck, Purcell or their combination describes each and every claim element, claims 18 and 19 are allowable over the combination of Breck and Purcell for at least these reasons.

### **Conclusion**

In view of the foregoing remarks, this application is now in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is invited to call the Applicant's attorney at the number listed below.

No Fees are believed due other than the fee for the RCE being filed herewith. However, please charge any additional fees due or credit any overpayment to Deposit Account No. 50-3025.

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Respectfully submitted,

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